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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,809	09/11/2003	Anthony J. Dezonno	95CR008/90458	5267

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WELSH & KATZ, LTD  
120 S RIVERSIDE PLAZA  
22ND FLOOR  
CHICAGO, IL 60606

EXAMINER

ANWAH, OLISA

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/659,809	DEZONNO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Olisa Anwah	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 1-24 is/are withdrawn from consideration.
- 5) ☒ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 25-46 are rejected under the judicially created doctrine of double patenting over claims 1-29 of U.S. Patent No. 6,282,284 and claims 1-9 of U.S. Patent No. 6,621,899 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent..

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

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entering into a computer a request by the computer user for a return communication by voice from the agent to the computer user in response to a prompt to the computer user to enter a request;

transmitting the request from the computer over a computer network to a computer controlled system; and

establishing communication by voice between the agent and the operator through the computer controlled system

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 25, 27, 31, 37, 42, 45 and 46 are rejected under 35 U.S.C. § 102(e) as being anticipated by Freeman et al, U.S. Patent No. 5,428,608 (hereinafter Freeman).

Regarding claim 25, Freeman discloses a method for establishing communication by voice between a computer user and at least one agent, the computer user being associated with a computer, the method comprising:

entering into the computer a request by the computer user for a return communication by voice from the agent to the computer user in response to a prompt to the computer user to enter a request;

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transmitting the request from the computer over a computer network to a computer controlled system; and

establishing communication by voice between the agent and the operator through the computer controlled system (see Figure 6).

As per claim 27, see Figure 6 of Freeman.

On the issue of claim 31, see Figure 6 of Freeman.

Regarding claim 37, see column 13 of Freeman.

Regarding claim 42, Freeman discloses a communication system for establishing communications by voice between a computer user and at least one agent, the computer user being associated with a user computer, and entering a request in the user computer for a return communication by voice from the at least one agent in response to being prompted to enter the request, the communication system comprising:

an agent voice communication device associated with the agent;

a computerized system which receives the request for communication from the user computer, converts the request into a command formatted for use by the computerized system to establish a return communication link, and provides computer

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user information to at least one agent regarding the requested return communication (see Figure 6).

On the issue of claim 45, see Figure 6.

Regarding claim 46, see Figure 6.

***Claim Rejections - 35 USC 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 26, 29, 30, 34, 35, 38-41, 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman in view of Payne et al, U.S. Patent No. 5,715,314 (hereinafter Payne).

On the issue of claim 26, Freeman teaches establishing a page which provides an indicia which can be activated to initiate the request for return communication by voice (see Figure 6). Freeman doesn't explicitly teach the page is a web page. All the same, Payne discloses this limitation (see Figure 14). Consequently, it would have been obvious to one of ordinary

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skill in the art at the time the invention was made to modify Freeman with the web page of Payne. This modification would have modernized Freeman by implementing an open marketplace for goods or services over computer networks such as the Internet as suggested by Payne (see column 1).

Regarding claim 30, Freeman fails to teach the step of providing to the agent at least one of a name of the computer user and other computer user information. Conversely, Payne shows this feature (see Figure 14). And so it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Freeman with the web page of Payne. This modification would have immensely improved the user satisfaction of Freeman by allowing the user to request customer service as suggested Payne (see column 9).

With respect to claim 34, Freeman teaches a first page permits the computer user to request a return communication by voice. Freeman miserably fails to teach the first page is a web page and a second web page provides for entry of computer user information including at least one of computer user name, computer user telephone number and time for return communications by voice. All the same, Payne discloses these



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limitations (see Figure 14). Consequently, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Freeman with the web page of Payne. This modification would have modernized Freeman by implementing an open marketplace for goods or services over computer networks such as the Internet as suggested by Payne (see column 1).

As per claim 35, Freeman teaches the computer user exits the page without sending the request for return communications (see Figure 6). Freeman doesn't explicitly teach the page is a web page. All the same, Payne discloses this limitation (see Figure 14). Consequently, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Freeman with the web page of Payne. This modification would have modernized Freeman by implementing an open marketplace for goods or services over computer networks such as the Internet as suggested by Payne (see column 1).

Regarding claim 38, Freeman discloses a method of communication between a computer user and at least one agent, the computer user being associated with a user computer, the method comprising:

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establishing a page on the user computer which prompts the computer user to enter a request for a return communication by voice;

entering in the user computer a request by the computer user for a return communication by voice from the agent to the computer user;

transmitting the request from the user computer over a computer network to a computerized system to establish a return communication by voice link and

converting the request into a command formatted for use by the computerized system to establish a return communication by voice link.

With further respect to claim 38, Freeman doesn't explicitly teach the page is a web page and providing computer user information to at least one agent regarding the requested return. All the same, Payne discloses these limitations (see Figure 14). Consequently, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Freeman with the web page of Payne. This modification would have modernized Freeman by implementing an open marketplace for goods or services over computer networks such as the Internet as suggested by Payne (see column 1).

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As per claim 39, Freeman explains the page provides an indicia which can be activated to initiate the request for return communication by voice (see Figure 6). Freeman doesn't explicitly teach the page is a web page. All the same, Payne discloses this limitation (see Figure 14). Consequently, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Freeman with the web page of Payne. This modification would have modernized Freeman by implementing an open marketplace for goods or services over computer networks such as the Internet as suggested by Payne (see column 1).

Regarding claim 40, see Figure 14 of Payne.

With respect to claim 41, Freeman shows a first page provides for the computer user to request a return communication by voice. Freeman doesn't teach the first page is a web page and a second web page provides for entry of computer user information including at least one computer user number and a time for the return communication. All the same, Payne discloses these limitations (see Figure 14). Consequently, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Freeman with the web page of Payne.

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This modification would have modernized Freeman by implementing an open marketplace for goods or services over computer networks such as the Internet as suggested by Payne (see column 1).

On the issue of claim 43, Freeman clearly explains a page is established on the user computer that prompts the computer use to enter the request and comprises an indicia which can be activated to initiate the request. Freeman doesn't explicitly teach the page is a web page. All the same, Payne discloses this limitation (see Figure 14). Consequently, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Freeman with the web page of Payne. This modification would have modernized Freeman by implementing an open marketplace for goods or services over computer networks such as the Internet as suggested by Payne (see column 1).

As for claim 44, Freeman teaches a first page on the user computer provides for the computer user to request the return communication. Freeman doesn't really teach the first page is a web page and a second web page provides for entry of computer user information. All the same, Payne discloses these limitations (see Figure 14). Consequently, it would have been obvious to one of ordinary skill in the art at the time the

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invention was made to modify Freeman with the web page of Payne. This modification would have modernized Freeman by implementing an open marketplace for goods or services over computer networks such as the Internet as suggested by Payne (see column 1).

Re Claim 29, Freeman fails to teach the step of entering the request comprises the step of providing a name of the computer user. Yet, Payne discloses this feature (see Figure 14). As a result, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Freeman with the web page of Payne. This modification would have improved the user friendliness by allowing computer users to request customer service as suggested by Payne (see column 9).

With further respect to claim 29, the combination of Freeman and Payne doesn't explicitly indicate to the agent the name of the computer user after establishing voice communications between the agent and the computer user. Nonetheless, Official Notice is taken that this limitation is both old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the combination of Freeman and Payne with a step of indicating to the agent the name of the computer user after establishing voice communications between

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the agent and the computer user. This modification would have improved the system s convenience by providing the computer user with voice assistance as suggested by Freeman (see column 4).

7. Claim 36 is rejected under 35 U.S.C 103(a) as being unpatentable over Freeman in view of Stein et al, U.S. Patent No. 5,826,241 (hereinafter Stein).

Regarding claim 36, nowhere does Freeman mention the computer network comprises at least one bulletin board. However Stein reveals this mystery (see column 3). As a result, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Freeman with the bulletin board of Stein. This modification would have improved the flexibility of Freeman by allowing merchants to advertise their products via various media as suggested by Stein (see column 3).

8. Claim 28 is rejected under 35 U.S.C 103(a) as being unpatentable over Freeman combined with Payne in further view of Srinivasan, U.S. Patent No. 5,185,782 (hereinafter Sri Sri).

As per claim 28, Freeman fails to teach the step of entering the request comprises entering a time to call the computer user. However Payne discloses this limitation (see Figure 14). Therefore it would have been obvious to one ordinary

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skill in the art at the time the invention was made to modify Freeman with the web page of Payne. This modification would have significantly improved the user satisfaction of Freeman by allowing the computer user to request customer service as suggested by Payne (column 9).

Further regarding claim 28, the combination of Freeman and Payne fails to explain the step of machine dialing the telephone number comprises the step of dialing the telephone number at the time of the call. Nonetheless, Sri Sri discloses this limitation (see abstract). Hence it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the combination of Freeman and Payne with the dialing feature of Sri Sri. This modification would have improved the system's user friendliness by returning calls at the customer's convenience as suggested by Sri Sri (see column 1).

9. Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman in view of Sri Sri.

Regarding claim 32, Freeman miserably fails to teach the claimed redialing limitation. All the same, Sri Sri teaches this feature (see abstract). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was

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made to modify Freeman with the redialing limitation of Sri Sri. This modification would have improved the user friendliness of Freeman by returning calls at the customer s convenience as suggested by Sri Sri (see column 1).

As per claim 33, see 102 of Sri Sri.

### ***Response to Arguments***

10. Applicant s arguments have been considered but are deemed to be moot in view of the new grounds of rejection.

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olisa Anwah whose telephone number is 571-272-7533. The examiner can normally be reached on Monday to Friday from 8.30 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner s supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 571-273-8300 for After Final communications.

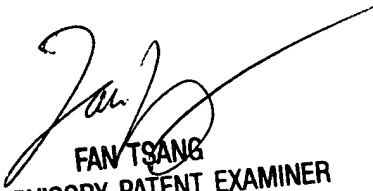


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.

O-A-

Olisa Anwah  
Patent Examiner  
October 26, 2005

  
FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600